

### **REMARKS/ARGUMENTS**

These Remarks are responsive to the Office Action mailed January 10, 2005 ("Office Action"). The Office Action has been reviewed, and in view of the foregoing amendments and following remarks, reconsideration and allowance of all of the claims pending in the application are respectfully requested.

#### **Claim Objections**

Claims 23 and 33 are currently objected to as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicants have amended claims 23 and 33 to further clarify an embodiment of the invention. Accordingly, the objections should be withdrawn.

#### **Rejection under 35 U.S.C. § 112**

Claims 24 and 34 are currently rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. More specifically, the Office Action alleges that "few" renders the claims indefinite. Applicants have amended claims 24 and 34 to further clarify an embodiment of the invention. Accordingly, the rejections under 35 U.S.C. § 112, second paragraph, should be withdrawn.

#### **Rejection under 35 U.S.C. § 103(a)**

Claims 21-24 and 31-34 are rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over U.S. Patent No. 4,719,909 to Micchia *et al* ("Micchia") in view of U.S. Patent No. 1,300,592 to Essig ("Essig"). Applicants respectfully disagree.

The Examiner acknowledges that Micchia does not disclose that the decal also comprises

a shape formed within the exterior surface which has a color contrasting to the non-reflective color and is configured to provide communication (Office Action mailed 1/10/05, page 4). For these major deficiencies, the Office Action applies Essig which discloses a decorative “beauty mark” that releases perfume while the article is being worn and subjected to heat and moisture of the body (Essig, col. 1, lines 9-17). The Office Action has failed to provide proper motivation for combining Micchia and Essig. Rather, the Office Action alleges that it would have been obvious to provide the decal of Micchia with a shape formed within the exterior surface which has a color contrasting to the non-reflective color in order to provide communication, “motivated by the fact that Essig ... discloses that where a part of the decal (patch) 4 is to be exposed, it is desirable to impart a particular hue or color [to] the exposed .. part of the decal ... such that the whole surface or only parts of the surface have [sic] ornamental material applied thereto” (Office Action mailed 1/10/05, page 5). Therefore, the alleged “motivation” relied upon by the Office Action for modifying Micchia is because Essig discloses an ornamental decal. This statement of motivation fails for at least the following reasons.

Micchia specifically discloses a light absorbing surface 12 comprising a non-reflective, black, hypo-allergenic coating uniformly applied over the surface of the body sheet 11 (col. 2, lines 37-45). Thus, the surface of Micchia’s patch is uniform and black. The beauty mark invention of Essig contains perfume that is released while the article is being worn and subjected to heat and moisture of the body. There is no reason, absent improper hindsight, for completely modifying the uniform and black patch of Micchia that is applied right under the eye area to include the ornamental design of Essig, which is filled with perfume and released when subjected to heat and moisture of the body. There is nothing in Essig that would motivate one of ordinary skill in the art to apply the teachings associated with Essig’s decal to the invention of

Micchia. Essig's decal releases perfume in response to heat and moisture of the body. The eye area releases minimal heat and moisture. Further, it would not be desirable or safe to apply the ornamental decal of Essig that releases perfume under the eye area. The alleged "motivation" relied upon by the Office Action is based purely on hindsight. In fact, the Office Action has failed to provide a proper statement of motivation, but rather relies upon the mere fact that Essig shows an ornamental design applied to a completely different area for a completely different purpose and function.

The Office Action alleges that the beauty mark "communicates to the viewer an image of a butterfly" (Office Action mailed 1/10/05, page 7). Contrary to the Office Action's allegations, the beauty mark of Essig is purely decorative and fails to provide communication. There is no suggestion to combine the beauty mark of Essig which is worn on the body where heat and moisture release perfume with the device of Micchia which is applied under the eye area. In fact, Micchia specifically teaches that the surface of the patch is uniform and black. The Office Action has failed to rely on any teaching of Essig for the purpose of drastically modifying the patch of Micchia.

The Office Action has failed to set forth a *prima facie* case of obviousness. Specifically, when a primary reference is missing elements, the law of obviousness requires that the Office set forth some motivation why one of ordinary skill in the art would have been motivated to modify the primary reference in the exact manner proposed. *Ruiz v. A.B. Chance Co.*, 234 F.3d 654, 664 (Fed. Cir. 2000). In other words, there must be some recognition that the primary reference has a problem and that the proposed modification will solve that exact problem. All of this motivation must come from the teachings of the prior art to avoid impermissible hindsight looking back at the time of the invention.

In the present case, the Office Action's justification for modifying Micchia and Essig has absolutely nothing to do with the deficiencies of Micchia. As admitted by the Office Action, Micchia fails to show at least "that the decal also comprises a shape formed within the exterior surface which has a color contrasting to the non-reflective color and is configured to provide communication." To properly modify Micchia to correct for these major deficiencies, the Office Action has the burden to show some motivation why providing those elements would have overcome some perceived problem with Micchia. Any such motivation is completely lacking.

Accordingly, the Office Action has failed to provide any proper motivation for modifying Micchia as taught by Essig, so the proposed modification fails. In fact, Micchia and Essig are improperly combined and lack proper motivation. Even if Micchia and Essig could be modified as suggested by the Office Action, the resulting combination would nevertheless fail to show each and every limitation claimed by Applicants.

The mere fact that Micchia and Essig can be somehow combined and modified does not render the resultant modification obvious unless there is a suggestion or motivation found somewhere in the prior art regarding the desirability of the combination or modification. *See* M.P.E.P. § 2143.01; *see also In re Mills*, 16 U.S.P.Q.2d 1430, 1432 (Fed. Cir. 1990); *In re Fritz*, 23 U.S.P.Q.2d 1780 (Fed. Cir. 1992). In addition, the teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in Applicants' disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991).

Claims 22-30 and 32-40 all depend ultimately from one of independent claims 21 and 31, respectively. As such, each of these dependent claims contain each of the features recited in the independent claims. For the reasons stated above, Micchia in combination with Essig fails to

disclose the claimed inventions and the rejections should be withdrawn. Additionally, these claims are separately patentable over Micchia in combination with Essig.

Claims 26-30 and 36-40 are rejected as being unpatentable over Micchia *et al* in view of Essig and further in view of US Patent No. 5,470,351 to Ross *et al*. Claims 25 and 35 are rejected as being unpatentable over Micchia *et al* in view of Essig and further in view of Ross *et al* and US Patent No. 4,522,864 to Humason *et al*. The additional references fail to obviate the admitted deficiencies of Micchia *et al*. Neither Ross nor Humanson provides any teaching directed to the missing elements of the claims. Ross is directed to creating a suntan tattoo utilizing an applique. Humanson is directed to using multi-color offset printed design. Neither reference provides any teaching directed to modifying the uniform black patch of Micchia that is applied under the eye area to include a material having “a shape formed within the exterior surface, wherein the shape has a color contrasting to the non-reflective color” and “is configured to provide communication.” The applied references simply fail to obviate the claimed combination of limitations.

The initial burden is on the Examiner to provide some suggestion of the desirability of doing what the inventors have done. The Examiner has clearly failed to reach the initial burden.

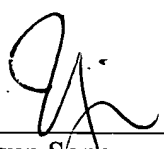
**CONCLUSION**

In view of the foregoing amendments and arguments, it is respectfully submitted that this application is now in condition for allowance. If the Examiner believes that prosecution and allowance of the application will be expedited through an interview, whether personal or telephonic, the Examiner is invited to telephone the undersigned with any suggestions leading to the favorable disposition of the application.

It is believed that no additional fees are due for filing this Response. However, the Director is hereby authorized to treat any current or future reply, requiring a petition for an extension of time for its timely submission as incorporating a petition for extension of time for the appropriate length of time. Applicants also authorize the Director to charge all required fees, fees under 37 C.F.R. §1.17, or all required extension of time fees, to the undersigned's Deposit Account No. 50-0206.

Respectfully submitted,  
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